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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-294

L. GOLDSTEIN'S SONS, INC.,

Petitioner,

vs.

TRIO PROCESS CORPORATION,

Respondent.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE

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TABLE OF CONTENTS

	PAGE
Motion For Leave To File Brief Amicus Curiae	1a
Brief On Behalf Of The Ford Motor Company, Amicus Curiae	1
I Authority To File	1
II Interest Of The Ford Motor Company	1
III The Issue Presented	2
IV Reasons To Grant Certiorari	4
A. The Conflict Among The Circuits	4
B. The Ramifications Of The File Wrapper Estoppel Doctrine	6
Conclusion	9

TABLE OF CITATIONS

CASES:

	PAGE
Bishman Mfg. Co. v. *Stuart-Warner Corp.*, 380 F.2d 336 (7 Cir.), *cert. denied*, 389 U S. 897 (1967)	4n
Deepsouth Packing Co. v. *Laitram Corp.*, 301 F. Supp. 1037, 1060 (E.D. La. 1969), *aff'd* on other grounds, 443 F.2d 928 (5 Cir 1971), *rev'd* on other grounds, 406 U.S. 518 (1972)	5n
Ellipse Corp. v. *Ford Motor Co.*, 452 F.2d 163, 168 (7 Cir.), *cert. denied*, 406 U.S. 948 (1972), pet. for rehearing filed, July, 1972, Sup. Ct. Doc. No. 71-1147	1, 5n
Graver Tank & Mfg. Co. v. *Linde Air Prods. Co.*, 339 U.S. 605, 617 (1950)	6
Keating v. *Stearnes Imperial Co.*, 347 F.2d 444 (7 Cir. 1965)	4n
Powder Power Tool Corp. v. *Powder Actuated Tool Co.*, 230 F.2d 409 (7 Cir. 1956)	4n
Schriber-Schroth Co. v. *Cleveland Trust Co.*, 311 U.S. 211, 221 (1940)	8n

RULES:

Rule 42, Rules Of The Supreme Court	1
Rule 58(2), Rules Of The Supreme Court	2

Other Authorities

Koykka, *Infringement of Patents*, 42 F.R.D. 43, 67 (1967)	3, 7n

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MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Ford Motor Company hereby respectfully moves for leave to file the attached brief *amicus curiae* in this case, presenting views, cases and analysis generally supportive of Petitioner's position which may not be advanced by either party. The consent of the attorney for the Petitioner has been obtained. The consent of the attorney for the Respondent was requested but refused, thus necessitating the filing of this motion under Supreme Court Rule 42(3).

The interest of the Ford Motor Company in this case arises from the fact that it is currently petitioning for a rehearing of the denial of a petition for certiorari in *Ford Motor Co.* v. *Ellipse Corp.*, Sup. Ct. Docket No. 71-1147. The First Question presented in Ford's petition for certiorari is identical to the First Question of the present petition.

The Circuit Courts of Appeal are in conflict on the question of what circumstances will estop a patentee from taking a position as to the meaning of claims when asserting them during litigation inconsistent with the position taken before the Patent Office when obtaining the claims, and both petitions seek a resolution of this conflict. This question

is referred to as the scope of the file-wrapper estoppel doctrine.

In the instant case, Petitioner has presented and analyzed some, but not all, of the cases and authorities demonstrating the conflict among the Circuits on this issue. Movant has done exhaustive research on this particular question and it is believed that the attached brief, which *amicus curiae* is requesting permission to file, supplements the Petitioner's presentation, analysis and portrayal of the split among the Circuits on this issue, as well as presenting an analysis of some important ramifications of the file-wrapper estoppel doctrine not presented by Petitioner.

Such additional analysis and research should materially assist the Court in reaching a decision to grant Certiorari on this issue which in turn should produce a uniform rule on file-wrapper estoppel in the federal trial and appellate courts.

This motion has been filed as soon as possible after learning that the issue of file-wrapper estoppel had been presented in the instant petition.

Accordingly, granting of this motion is earnestly requested.

Respectfully submitted,

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BRIEF ON BEHALF OF THE FORD MOTOR COMPANY, AMICUS CURIAE

I. AUTHORITY TO FILE

This *amicus curiae* brief is presented pursuant to Rule 42 of the Rules of the Supreme Court, together with movant's motion for leave to file the same.

II. INTEREST OF THE FORD MOTOR COMPANY

In March of 1972, Ford Motor Company (hereinafter Ford) filed a Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit in the case of *Ford Motor Co.* v. *Ellipse Corp.*, Sup. Ct. Doc. No. 71-1147. That Petition was denied on May 22, 1972, Mr. Justice Douglas noting his view that the writ should have been granted. In July, 1972, after being granted an

extension of time, Ford filed a Petition for Rehearing of the Court's order denying certiorari. The Petition for Rehearing is based on "other substantial grounds available to petitioner although not previously presented. . . ." (Sup. Ct. Rule 58(2)) and is presently pending before this Court.

Ford has just recently become aware that the precise question which it raised in its Petition for Certiorari, has now been independently raised by the Petitioner in this case. Ford has no concern with and expresses no views on the private interests of the parties to this litigation. Ford seeks only to aid this Court in deciding whether to grant certiorari to review the important question of the proper application of the basic doctrine of file-wrapper estoppel. Since this precise question was exhaustively researched by Ford in connection with its own petition for certiorari, it is felt that Ford can bring valuable assistance to this court in demonstrating that the question presented is one of critical importance in patent law deserving review by this Court.

III. THE ISSUE PRESENTED

The doctrine of file-wrapper estoppel has always been basic to the proper administration and application of the patent laws. An application spends anywhere from many months to many years in the United States Patent Office before it becomes an issued patent. During this time those charged with the duty to do so, the Patent Office Examiners, carefully examine each application to insure its compliance with myriad statutory requirements. The work of these Examiners and the changes in the application made to make it comply with these statutory requirements, are all carefully recorded in the record of the application called the file-wrapper. It is this record which tells the world how the patent is to be construed and interpreted. Without it,

the words of an issued patent could be unduly manipulated to assume different meanings depending on the circumstances of the moment. Simply stated, the doctrine of file-wrapper estoppel, estops an inventor from later changing the positions, reflected in the file-wrapper, which he took when obtaining his patent. The doctrine has been described as follows:

> "In the course of the proceedings seeking the grant of a patent, the inventor will have said many things in explanation of his invention. He may have given up some claims, added others, modified language here and there.
>
> If, in order to obtain his patent, the inventor gives up a claim, or restricts what he has claimed, he is thereafter bound by that surrender. This is the same doctrine that would be applied in the construction of a contract. If, in the negotiation of a contract, one of the parties objects to particular language on the ground it covers matter he is not willing to have covered by the contract, and the other agrees to exclude it, and language then is altered for the purpose of excluding that particular matter, that contract cannot thereafter be construed to bring back into it what the parties agreed to exclude. No matter what construction may be given to the substituted language, it may not thereafter be read to bring that particular matter back into the contract." [1]

Thus, it is apparent that the doctrine of file-wrapper estoppel is a basic tool in the interpretation of any patent. Yet, as pointed out in the instant petition and in Ford's petition, the Circuit Courts of Appeal are hopelessly divided on the question of under what circumstances this vital doctrine will apply. Certain Circuits have held that the change in position taken by the applicant in the Patent Office, must have been in response to a *prior art rejection*

1. Koykka, *Infringement of Patents*, 42 F.R.D. 43, 66-67 (1967).

in order for file-wrapper estoppel to apply. On the other hand, other Circuits have held that changes in position taken by the applicant for other reasons can also result in estoppel. It is petitioner's contention, which this *amicus curiae* brief supports, that this sharp conflict should be resolved by this Court.

IV. REASONS TO GRANT CERTIORARI

A. *The Conflict Among The Circuits*

The instant petition sets out and analyzes decisions of the various Circuit Courts of Appeal establishing the conflict among the Circuits. Ford, as *amicus curiae,* respectfully submits that the conflict is even more deep-rooted than Petitioner suggests. Thus, Petitioner asserts that the Seventh Circuit case[1] cited by the Court below and other cases[2] located by Petitioner put the Seventh Circuit with those courts which do *not* limit file-wrapper estoppel to prior art rejections.[3] However, the Petition fails to note the very definite position taken by the Seventh Circuit in the case in which *amicus curiae* is a party, wherein the Seventh Circuit stated:

> "The application of the doctrine is limited to changes made to overcome rejections by the Patent Office because the claim was anticipated by the prior art. . . . It will not apply where changes in the claim are

1. *Bishman Mfg. Co.* v. *Stuart-Warner Corp.,* 380 F.2d 336 (7th Cir.), *cert. denied,* 389 U. S. 897 (1967).

2. *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.,* 230 F.2d 409 (7th Cir. 1956); *Keating* v. *Stearnes Imperial Co.,* 347 F.2d 444 (7th Cir. 1965).

3. Pet. pp. 11-12, 15. The Petition for Certiorari filed herein is referred to throughout this brief as Pet.

> directed to merely overcoming difficulties in particular wording or indefiniteness. . . .[1]

Accordingly, there is a conflict within the Seventh Circuit itself as well as among the Circuit Courts of Appeal.

At this juncture, about the only thing that seems clear is that there is great confusion within and among the Circuit Courts of Appeal as presented by the instant Petition, the Ford Petition and recognized by a district judge in the following language:

> "Plaintiff urges that the doctrine of file-wrapper estoppel applies only to those claims amended or withdrawn in order to overcome objections based on the prior art, correctly citing as authority the decision of the Tenth Circuit in McCullough Tool Co. v. Well Surveys, Inc., 1965 343 F.2d 381, 403, in which the Court said the doctrine 'is not applicable where the patentee's difficulty results not from prior art similarities but from the wording and indefiniteness of the claims.' And, other courts have referred to the doctrine, in *dicta,* in the terms of prior art rejections. On the other hand, the First and Sixth Circuits have said the doctrine extends to all cancellations and amendments, not just those based on the prior art. See, Borg-Warner Corp. v. Paragon Gear Works, 1 Cir., 1965, 355 F.2d 400; Parke-Davis & Co. v. American Cyanamid Co., 6 Cir., 1953, 207 F.2d 571."[2]

It is respectfully submitted that this conflict has grown to such proportions that it can only be resolved by this Court.

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1. *Ellipse Corp.* v. *Ford Motor Co.,* 452 F.2d 163, 168 (7th Cir.), *cert. denied,* 406 U.S. 948 (1972), Pet. for rehearing filed, July 1972, Sup. Ct. Doc. No. 71-1147.

2. *Deepsouth Packing Co.* v. *Laitram Corp.,* 301 F. Supp. 1037, 1060 (E.D. La. 1969), *aff'd* or other grounds, 443 F.2d 928 (5 Cir. 1971), *rev'd on other grounds* 406 U.S. 518 (1972) (footnotes omitted).

B. *The Ramifications Of The File-Wrapper Estoppel Doctrine*

Petitioner has amply presented one reason why resolution of the above-mentioned conflict is essential, namely to restore a degree of certainty to the interpretation of patent claims.[1] In the case of the business man dealing with an issued patent, this will encourage him to undertake non-infringing research and development, secure in the knowledge that what does not infringe in one Circuit is not likely to be deemed to infringe in another. Secondly, from the viewpoint of the courts, it will discourage forum shopping, a practice which the Court has always discouraged.

However, the proper resolution of the conflict has far greater ramifications, not discussed by Petitioner, and thus presented here, *amicus curiae*. While as stated earlier, Ford as *amicus curiae* has no interest in the outcome of this litigation, it files this brief in support of the granting of certiorari because the Third Circuit Court of Appeals has erred in limiting the doctrine of file-wrapper estoppel *only* to situations involving prior art rejections.

The prime import of the doctrine of file-wrapper estoppel is as a fetter on the doctrine of equivalents. The dangers of the doctrine of equivalents were clearly spelled out by Mr. Justice Black in his dissent to the decision of this Court which expanded that doctrine. In *Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*,[2] Mr Justice Black stated:

> "The Court's ruling today sets the stage for more patent 'fraud' and 'piracy' against business than could be expected from faithful observance of the congressionally enacted plan to protect business against judicial expansion of precise patent claims. Hereafter a manufacturer cannot rely on what the language of a patent claims. He must be able, at the

1. Pet. pp. 16-17.
2. 339 U.S. 605, 617 (1950).

> peril of heavy infringement damages, to forecast how far a court relatively unversed in a particular technological field will expand the claim's language after considering the testimony of technical experts in that field. To burden business enterprise on the assumption that men possess such a prescience bodes ill for the kind of competitive economy that is our professed goal."

These dangers can only be avoided if there is something to prevent the unlimited expansion feared by Justice Black. That something is the doctrine of file-wrapper estoppel which has been explained in relation to the doctrine of equivalents as follows:

> "The doctrine of equivalents—which expands a patent claim—is sometimes referred to as a rule to prevent fraud on the inventor: to prevent the theft of his invention by one making insignificant changes to avoid the patent. On the other hand, the opposite —the constricting—doctrine of file-wrapper estoppel may be referred to as a rule to bar fraud on the Patent Office and the public: to prevent the patentee from reclaiming that which, in order to obtain his patent, he has surrendered. If an inventor gets a patent on the basis of representations he makes to the Patent Office, it is manifestly right and just that his patent, when it issues, be read in the light of those representations."[1]

If file-wrapper estoppel is limited to situations where there has been a prior art rejection it leads to the very unwarranted expansion of patent claims feared by Justice Black. For example, in the instant case it permits the patentee to reclaim a series of process steps which the Patent Office ruled were never disclosed in his application and thus not capable of being claimed by him. Thus,

1. Koykka, *Infringement of Patents, supra.*

although he could not have obtained such a claim in the Patent Office, he is awarded it by the Court just because the Patent Office did not object to his claim because of prior art, but rather because of one of the many other equally fundamental statutory requirements an applicant must comply with.

In addition, as explained in Ford's own Petition for Certiorari, this Court has held the doctrine of file-wrapper estoppel to apply to amendments which broaden claims as well as to those which narrow claims.[1] That is, a patentee should not be able to obtain a broad claim which he asserts against the public for many years, and then, when the claim is challenged, narrow the claim back to where it was originally because the broadened claim is so broad as to be invalid. However, a claim is never broadened in response to a prior art rejection. Thus, those courts which hold file-wrapper estoppel limited to situations where there is a prior art rejection, have *de facto* overruled this Court's holding in the *Schriber-Schroth* case since they will never apply file-wrapper estoppel to a broadening amendment.

It is apparent that the limitation of the file-wrapper estoppel doctrine has ramifications far greater than the forum shopping dangers discussed by Petitioner, and Ford, as *amicus curiae*, respectfully urges this Court to grant certiorari to review and settle this issue.

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1. *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 221 (1940).

CONCLUSION

For the reasons above stated, it is respectfully submitted that this Court should grant certiorari to resolve the conflict among the Circuit Courts of Appeal and should resolve this conflict by holding that file-wrapper estoppel is applicable to all changes in position taken in the Patent Office, not just those taken in response to a prior art rejection.

Respectfully submitted,

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